

### REMARKS

Claims 1-22 are now pending in this application. Claims 1-16 are rejected. Claims 17-19 are objected to. New claims 20-22 are added. Claims 1, 3-7, 9, 10, 12, 13 and 17-19 are amended herein to express the invention in alternative wording and to address matters of form unrelated to substantive patentability issues.

Applicants herein traverse and respectfully request reconsideration of the rejection of the claims and objections cited in the above-referenced Office Action.

Claim 4 is rejected as indefinite under 35 U.S.C. § 112, second paragraph, for failing to particularly point out and distinctly claim the subject matter of the invention as a result of an informality stated in the Office Action, including allegedly confusing language. The claim is amended to remove or correct the informality noted in the Office Action. Therefore, reconsideration of the rejection of the claim and its allowance are earnestly requested.

Claim 1 is rejected under 35 U.S.C. § 102(b) as being anticipated by Stein et al. (US 5,590,841). Applicant herein respectfully traverses this rejection. “Anticipation requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, *arranged as in the claim.*” *Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 221 USPQ 481, 485 (Fed. Cir. 1984) (emphasis added). It is respectfully submitted that the cited reference is deficient with regard to the following.

Claim 1 recites in pertinent part the following:

a grinding chamber containing grinding media;

a stator and a rotor which are arranged in the grinding chamber, said rotor being shaped as a rotationally symmetrical element, said stator being formed by an inner surface of the grinding chamber, said inner surface presenting a shape which essentially compliments the rotor surface, the rotor and the stator each having pins arranged over an entire respective surface thereof which extend from the respective surface and project into the processing space;

structure defining a grinding material input opening and a grinding material output opening for feeding and removing grinding material to or from the grinding chamber; and

a grinding medium separation device, arranged in the grinding chamber upstream from the output opening, used to separate grinding media entrained in the grinding material from the grinding material

before the grinding material is removed from the  
grinding space through the output opening

Claim 1 recites, *inter alia*, that the rotor and the stator each have pins arranged over an entire respective surface thereof which extend from the respective surface and project into the processing space. The cited Stein et al. reference fails to disclose such arrangement, and in accordance with which the respective surfaces of the rotor and stator are shared by deflection zones 10 and 11, which are devoid of pins (see Figs. 1 and 2) and grinding zones 8a and 8b, which are fitted with grinding pins 9a, 9b. Therefore, significant portions of the processing space in Stein et al. are devoid of a pin arrangement.

Claim 1 particularly describes and distinctly claims at least one element not disclosed in the cited reference. Therefore, reconsideration of the rejection of claim 1 and its allowance are respectfully requested.

Claims 2, 5 and 6 are rejected as obvious over Stein et al. in view of Stehr et al. (US 5,624,080) under 35 U.S.C. §103(a). Claims 3 and 4 are rejected as obvious over Stein et al. in view of the Japanese Patent (JP 2002-316061) under 35 U.S.C. §103(a). Claims 7-13, 15 and 16 are rejected as obvious over Stein et al. in view of the British Patent GB-1 277 715) under 35 U.S.C. §103(a). Claim 14 is rejected as obvious over Stein et al. in view of the British Patent, and further in view of Bishop

et al. (US 5,474,237) under 35 U.S.C. §103(a). The applicants herein respectfully traverse these rejections.

It is respectfully submitted that the respective proffered combinations of references cannot render the rejected claims obvious because each of the secondary Stehr et al., Japanese Patent, British Patent and Bishop et al. references does not provide the teaching noted above with respect to the anticipation rejection of parent claim 1 that is absent from the primary Stein et al. reference. Thus, the various combinations of prior art references fail to teach or suggest all the claim limitations, as properly required for establishing a *prima facie* case of obviousness. Therefore, reconsideration of the rejections of claims 2-16 and their allowance are respectfully requested.

Claims 17-19 are objected to as being dependent from a rejected base claim. The Examiner indicates that the claims contain allowable subject matter and would be allowed if put in independent form incorporating the limitations of the base and intervening claims. The claims are amended in accordance with the Examiner's suggestion. Claim 17 is placed in independent form with the remaining objected to claims 18 and 19 being dependent therefrom. Reconsideration of the objection and allowance of the claims are respectfully requested.

Independent claims 20-22 are added, and are respectively directed to the subject matter of claims 1, 2 and 14; claims 1 and 15; and claims 1 and dependent claim 17 prior to its amendment herein. The claims are submitted as patentable based

upon the arguments discussed above relative to such recitations. Favorable action of the merits is earnestly solicited.

Two (2) claims in excess of twenty are added. Two (2) further independent claims in excess of three are added. Accordingly, please charge the fee of \$500 to Deposit Account No. 10-1250.

Applicants respectfully request two (2) three month extension of time for responding to the Office Action. Please charge the fee of \$450 for the extension of time to Deposit Account No. 10-1250.

The USPTO is hereby authorized to charge any fee(s) or fee(s) deficiency or credit any excess payment to Deposit Account No. 10-1250.

Docket No. F-8543

Ser. No. 10/525,613

In light of the foregoing, the application is now believed to be in proper form  
for allowance of all claims and notice to that effect is earnestly solicited.

Respectfully submitted,  
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